


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 12258-036001
I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450. _____ Date of Deposit _____ Signature _____ Typed or Printed Name of Person Signing Certificate	Application Number 10/615,279	Filed July 8, 2003
	First Named Inventor Jeff Korn	
	Art Unit 3737	Examiner William C. Jung
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>41,942</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		
<div style="text-align: right;">  _____ Signature _____ Faustino A. Lichauco Typed or printed name _____ (617) 542-5070 Telephone number _____ August 21, 2006 Date </div>		
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.		
<input type="checkbox"/> Total of _____ forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Jeff Korn	Art Unit :	3737
Serial No. :	10/615,279	Examiner :	William C. Jung
Filed :	July 8, 2003	Conf. No. :	8225
Title :	OPTICAL COUPLER FOR ROTATING CATHETER		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to USPTO OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, Applicant requests a review of identified matters on appeal by a panel of examiners. Applicant submits that the rejections of record are clearly improper and without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-16 are pending, with claims 1 and 10 being independent. Claims 1-26 stand rejected both for obviousness-type double-patenting and under 102(f) in view of *Zuluaga*, under 35 U.S.C. 102(e) as anticipated by *Seibel*. Reference is hereby made to the arguments already of record regarding the failure to establish anticipation and double-patenting as set forth in the response filed on February 9, 2006.

The presently claimed subject matter, as exemplified in claim 1, is directed to a way to couple a stationary housing to a rotating catheter that has a collection fiber and a delivery fiber extending through it. A difficulty that arises is that the collection fiber revolves around an axis of rotation. The delivery fiber extends along the catheter's axis of rotation, and therefore does not trace out an orbit as does the collection fiber.

Double-patenting rejection

An obviousness-type double-patenting rejection of a claim would only be proper if the rejected claim recited an obvious variation of a claim in *Zuluaga*. It is not enough that a claim in *Zuluaga* dominates the rejected claim or vice versa.

Applicant's claim 1 recites

"a beam re-director disposed between the lens and the distal face, the beam re-director being oriented to direct a delivery beam toward the central port."

Applicant speculates that the Examiner regards this "beam re-director" as corresponding to the "first optical relay" of *Zuluaga* claims 1 and 4 because both the claimed "beam redirector" and *Zuluaga*'s "first optical relay" interact with the delivery beam.

The *Zuluaga* claims limit "first optical relay" in functional terms as a structure for "guiding a first beam from the central aperture to a central port." There is no requirement in *Zuluaga*'s claim 1 of re-directing a beam.

In contrast, Applicant's recitation of "beam redirector" is far more specific than *Zuluaga*' recitation of a "first-optical relay." Applicant's claim 1 recites a "beam re-director," rather than a relay, and places this beam re-director at a particular location, namely "between the lens and the distal face."

It may be useful to compare examples of *Zuluaga*'s "first optical relay" (see elements numbered 62, 64 in FIG. 3; See also references numbered 56, 52 in FIGS. 5, 6) with Applicant's FIG. 8. The *Zuluaga* figures clearly show examples of a "first optical relay" that omits any "beam redirector".

While the recitation of "first optical relay" in *Zuluaga*'s claim 1 may cover the claimed "beam re-director," that is a test for infringement, not for double-patenting. The fact that one claim element in *Zuluaga* might be construed to cover the recitation of a corresponding claim element in Applicant's claim 1 does not mean that the two claims recite obvious variants of the same subject matter.

Section 102(f) rejection

A rejection under 35 U.S.C. §102(f) is appropriate “[w]here it can be shown that an applicant ‘derived’ an invention from another ...”.¹ Here, the Examiner has provided no such showing. Instead, the Examiner relies on the double-patenting rejection, which as noted above is improper to begin with, and the lack of common inventorship.²

The mere fact that *Zuluaga* discloses subject matter allegedly covered by the pending claims but names a different inventive entity is insufficient to support a rejection under 35 U.S.C. §102(f):

Where there is a published article identifying the authorship (MPEP §715.01(c)) or a patent identifying the inventorship (MPEP §715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does *not* raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. 102(f).³

Furthermore, the inventor, Mr. Korn, has signed a declaration stating that he believes he is the first and original inventor of the subject matter claimed. This declaration creates a presumption that Mr. Korn is in fact the inventor.⁴

Thus, the Examiner has not met the burden of overcoming this presumption and establishing that Mr. Korn *derived* his claimed invention from Mr. Zuluaga et al. In view of the foregoing, Applicant requests reconsideration and withdrawal of the rejections under 35 U.S.C. §102(f).

SECTION 102(e) REJECTION

Claim 1 recites

a housing with
a rotatable distal face and

a stationary proximal face,

¹ *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981).

² *Final Office Action*, page 2, line 12.

³ *MPEP* §2137 [emphasis added].

⁴ *MPEP* §2137.01(I), citing *Driscoll v. Cebalo*, 5 USPQ2d 1477, 1481 (Bd. Pat. Inter. 1982).

the distal face having
an eccentric port and
a central port

Seibel's housing lacks "a rotatable distal face"

The only structure in *Seibel* that could reasonably be regarded as a housing is what which *Seibel* itself refers to as a "cylindrical supporting housing 222"⁵ in FIG. 5F. But this housing 222 does not have "a rotatable distal face." The distal face of the housing 222 is simply an aperture covered by a lens 238.

The only structures in *Seibel* that undergoes any rotary motion is the fiber 208, the tip of which, like a whip, orbits a point in response to activation of what *Seibel* calls "a piezoceramic tube actuator 206." But the whip-like fiber 208 cannot reasonably be regarded as a "distal face" of the housing 222. After all, the fiber 208 is not even part of the housing 222, it is simply one of several structures that the housing 222 encloses.

Seibel's housing lacks a distal face having "an eccentric port and a central port"

It is also apparent that the *Seibel* housing 222 does not have both "an eccentric port and a central port."

The only "port" in the *Seibel* housing 222 is the aperture covered by a lens 238. This could be regarded as a "central port." But there is clearly no "eccentric port" in 222. Applicant notes that the faces 202 cannot be regarded as eccentric ports because they are not part of the housing 222.

SECTION 102(e) REJECTION OF CLAIM 10

In connection with the "housing" of claim 10, Applicant incorporates the arguments made above in connection with claim 1.

The fiber 208 is not a "rotating catheter"

Claim 10 recites the additional limitation of

⁵ *Seibel*, col. 14, lines 48-49.

“a rotating catheter having a collection fiber and a delivery fiber extending therethrough;”

The only structure in *Seibel* that can be said to rotate is the fiber **208**, the tip of which whips around a point in response to activation of what *Seibel* calls “a piezoceramic tube actuator **206**.” But the whip-like fiber **208** is not a “rotating catheter.” It is simply an optical fiber.

The fiber 208 lacks fibers extending therethrough

The fiber **208** is a single unitary fiber. It does not have “a collection fiber and a delivery fiber extending therethrough” as required by the claim. There is no suggestion anywhere in *Seibel* of both a collection fiber and a delivery fiber that extend through any rotating structure.

With regard to the dependent claims 3-5, 9, 11-14, and 16, Applicant incorporates herein the observations set forth on pages 5-6 of the response filed on February 9, 2006.

With regard to the dependent claims 5, 9, 14 and 16, incorporates herein the observations set forth on page 6 of the response filed on February 9, 2006.

Payment of fees

Please charge payment for the notice of appeal, and any other fees that may be due, to our deposit account 06-1050, referencing attorney docket “11125-036001.”

Respectfully submitted,

Date: 8/21/2006


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